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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,499	12/18/2003	Andrew M. Bober	JD-427	1498

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/707,499

Applicant(s)

BOBER ET AL.

Examiner

Alicia Chevalier

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/27/04 + 3/22/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-21 is/are pending in the application, claims 20 and 21 are withdrawn from consideration.

#### *Election/Restrictions*

2. Applicant's election without traverse of Group I, claims 1-19, in the reply filed on July 7, 2005 is acknowledged.
3. Claims 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 7, 2005.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bull et al. (U.S. Patent Application No. 2001/0006714 A1).

Regarding Applicant's claim 12, Bull discloses a surface modifying laminate (*graphic article, title*) comprising a perforated carrier film (*imageable film, paragraph 0032*) having an upper surface and a lower surface (*figure 3*), the film at least partially covering a surface to be

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modified (*figure 3*), an indicia-containing layer (*image layer, paragraph 0039*) disposed on at least a portion of the lower surface of the carrier film (*figure 3*).

Regarding Applicant's claim 13, Bull discloses that the carrier film is transparent film (*paragraph 29*), such that the indicia-containing layer is visible through the carrier film (*figure 3*).

Regarding Applicant's claim 14, Bull discloses that the indicia-containing layer is substantially continuous layer covering substantially the entire carrier film (*figure 3*).

Regarding Applicant's claim 15, Bull discloses that the indicia-containing layer is printed onto the lower surface of the carrier film (*paragraph 39*).

Regarding Applicant's claim 16, Bull discloses that the carrier film comprises an average of at least 1 perforation per square foot (*paragraph 32*).

Regarding Applicant's claim 17, Bull discloses that the carrier film comprises an average of no more than about 200 perforations per square foot (*paragraph 32*).

Regarding Applicant's claim 18, Bull discloses that the carrier film comprises a film selected from the group consisting of polypropylene films, polyacetal films, polyamide films, polyanhydride films, polyester films, polyolefin films, polystyrene films, polyvinylchloride films, polyvinylidene chloride films, polyurethane films, and polyurea films (*paragraph 29*).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull in view of Orensteen et al. (U.S. Patent No. 5,508,105).

Regarding Applicant's claim 1 and 19, Bull discloses a surface modifying laminate (*graphic article, title*) comprising a carrier film (*imageable film, paragraph 0032*) having an upper surface and a lower surface (*figure 3*), the film at least partially covering a surface to be modified (*figure 3*), an indicia-containing layer (*image layer, paragraph 0039*) disposed on at least a portion of the lower surface of the carrier film (*figure 3*) and a top coat (*paragraph 0043*) disposed on at least a portion of the upper surface of the carrier film (*figure 3*).

Bull fails to disclose that the top coat is a cured top coat.

Orensteen discloses a signage article comprising a cured top coat (*multi-function coat, col. 8, line 35*) which is also crosslinked to improve weatherability (*col. 9, lines 12-21*).

Bull and Orensteen are analogous because they both disclose display/signage articles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Orensteen's top coat as the top coat in Bull in order to improve the weatherability of Bull's article.

Regarding Applicant's claim 2, Bull discloses that the carrier film is transparent film (*paragraph 29*), such that the indicia-containing layer is visible through the carrier film (*figure 3*).

Regarding Applicant's claim 3, Bull discloses that the indicia-containing layer is substantially continuous layer covering substantially the entire carrier film (*figure 3*).

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Regarding Applicant's claim 4, Bull discloses that the indicia-containing layer is printed onto the lower surface of the carrier film (*paragraph 0039*).

Regarding Applicant's claim 5, Bull discloses that the carrier film is perforated (*paragraph 0032*).

Regarding Applicant's claim 6, Bull discloses that the carrier film comprises a film selected from the group consisting of polypropylene films, polyacetal films, polyamide films, polyanhydride films, polyester films, polyolefin films, polystyrene films, polyvinylchloride films, polyvinylidene chloride films, polyurethane films, and polyurea films (*paragraph 0029*).

Regarding Applicant's claim 7, Orensteen discloses that the top coat is not alkali-soluble top coat (*col. 9, lines 12-21*).

Regarding Applicant's claim 8, Orensteen discloses that the top coat is a crosslinked top coat (*col. 9, lines 12-21*).

Regarding Applicant's claim 9, Bull discloses that the top coat is a permanent top coat (*paragraph 0043*).

Regarding Applicant's claim 10, Orensteen discloses that the top coat is selected from the group consisting of acrylic coatings, polyurethane coatings, vinyl coatings and epoxy coatings (*col. 10, lines 13-49*).

Regarding Applicant's claim 11, Bull discloses a boding layer disposed between the surface to be modified and the indicia-containing layer (*paragraph 0037 and figure 3*).


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***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alicia Chevalier  
Primary Examiner  
9/19/05